

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Breen, John J. et al	§	
Serial No. 10/628,921	§	Confirmation No.: 8117
Filed: July 29, 2003	§	Group Art Unit: 2838
For: AC-DC ADAPTER AND BATTERY	§	Examiner: Boateng, Alexis Asiedua
CHARGER INTEGRATION FOR	§	
PORTABLE INFORMATION	§	
HANDLING SYSTEMS [AS	§	
AMENDED]	§	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner For Patents
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Responsive to the Final Office Action dated March 13, 2008 and the Advisory Action, dated June 11, 2008 please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

THE EXAMINER HAS CONCEDED THAT REIPUR AND UNNO FAIL TO DISCLOSE ALL OF THE ELEMENTS OF THE CLAIMS

The claims rejected and pending are 1, 3-6, 8-10, 12, 14-15 and 19-21.

Claims 1, 3-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reipur (U.S. Patent No. 5,864,220) (Reipur hereinafter). Claims 12, 14-15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reipur in view of Unno (U.S. Patent No. 7,183,748 or WO 01/59905 for date purposes) (Unno hereinafter). Applicants respectfully submit that these rejections are not applicable to the pending claims and should be reversed.

A *prima facie* case of obviousness is missing, at least, because Reipur and Unno fail, alone or in combination, to support an obviousness rejection of the claimed subject matter because the references fail to teach all elements of the claims or to suggest the missing elements.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, at least, do not teach or suggest "a controller module included in the AC-DC adapter and operable to receive a first feedback signal input indicative of a target voltage required by a load, wherein the first feedback signal is an external feedback, and a second feedback signal input indicative of the second DC output, wherein the second feedback signal is an internal feedback, the controller module adjusting the control signal, responsive to the first and second feedback signal inputs, to the buck converter module to maintain the second DC output to be within a predefined range of the target voltage," as recited in independent claims 12 and 22 and substantially recited in independent claim 1, and defined throughout the figures specification of the pending application.

The Examiner has conceded that Reipur fails to teach all of the elements of the pending claims. The "Response to Arguments" section on page 7 of the Final Office Action mailed March 13, 2008, reads that the arguments "filed 2/05/08 with respect to the [35 U.S.C. 102] rejection(s) of claim(s) 1 under Reipur **have been fully considered and are persuasive**. Therefore, the rejection has been withdrawn." Emphasis added. Thus, the Examiner has clearly conceded that Reipur does not teach all of the elements of the pending claims.

In the Final Office Action, the Examiner made the same rejections, word-for-word, under 35 U.S.C. 103 as were previously proved with respect to 35 U.S.C. 102 where Applicant's response was found persuasive and thus the 35 U.S.C. 102 rejections were overcome. In other words, the rejections under 35 U.S.C. 102 that had been overcome were simply re-asserted as 35 U.S.C. 103 rejections word-for-word with the same reference locations and without adding

any reason why a person having ordinary skill in the art would find the claims obvious in light of the references.

According to the Federal Circuit, "[i]f the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). Thus, it is submitted that the rejection fails to produce a prima facie case of unpatentability. As such, this is a defective rejection and should be reversed.

It is well known that for a *prima facie* obviousness rejection to stand, all limitations of the claim must be evaluated. However, it is again submitted that a combination of the cited references could not teach or suggest all of the elements of the pending claims because all of the elements of the elements of the pending claims are not found in the references in any combination.

Therefore, to support these rejections with respect to claim 1, the references must contain all of the above-claimed elements. However, Reipur, at least, does not disclose "receiving the alternative current (AC) input; receiving a first feedback signal indicative of a target voltage required by the load, wherein the first feedback signal is an external feedback; receiving a second feedback signal indicative of the DC output, wherein the second feedback signal is an internal feedback; providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal; providing a converter in the AC-DC adapter; the controller module adjusting a control signal, responsive to receiving the first and second feedback signals, to the converter to maintain the DC output within a predefined range of the target voltage; and during a charging phase, a difference between the DC output and the target voltage is always positive while providing a charge to the load, and the DC output is reduced to a predefined value upon completion of providing the charge to the load," as defined in the specification and figures of the pending application.

For example, the Final Rejection states on page 2 that Reipur discloses in column 12, lines 49-61, receiving a first feedback signal indicative of a target voltage required by the load, wherein the first feedback signal is an external feedback. However, it is submitted that no such disclosure is found in that section of Reipur. To the contrary, the relevant section of Reipur relates to and discloses determining "the real value of the battery capacity" but, makes no reference to receiving a first feedback signal indicative of a target voltage required by the load, wherein the first feedback signal is an external feedback.

The Final Rejection also states on page 2 that Reipur discloses in column 14, line 51 – column 15, line 5, receiving a second feedback signal indicative of the DC output, wherein the

second feedback signal is an internal feedback. However, it is submitted that no such disclosure is found in that section of Reipur. To the contrary, the relevant section of Reipur relates to and discloses that "a more exact measurement is obtained if the charging current to the battery is cut off for a short period before the voltage is measured" but makes no reference to receiving a second feedback signal indicative of the DC output, wherein the second feedback signal is an internal feedback.

In fact, a search of Reipur reveals that the term "feedback" is not found anywhere in the specification of Reipur. Thus, it is submitted that Reipur could not disclose all of the elements of claim 1. As a result, the previous rejections based on 35 U.S.C. 102(b) cannot be supported by Reipur as applied to claim 1. Therefore, it is submitted that claim 1 and its dependent claims are allowable and thus, a notice of allowance of claims 1, 3-6 and 8-10 is respectfully requested.

Thus, Reipur fails to disclose or suggest receiving the alternative current (AC) input; receiving a first feedback signal indicative of a target voltage required by the load, wherein the first feedback signal is an external feedback; receiving a second feedback signal indicative of the DC output, wherein the second feedback signal is an internal feedback; providing a controller module included in an AC-DC adapter and operable to receive the first feedback signal and the second feedback signal; providing a converter in the AC-DC adapter; the controller module adjusting a control signal, responsive to receiving the first and second feedback signals, to the converter to maintain the DC output within a predefined range of the target voltage; and during a charging phase, a difference between the DC output and the target voltage is always positive while providing a charge to the load, and the DC output is reduced to a predefined value upon completion of providing the charge to the load." The deficiencies of Reipur, in this sense, are not remedied by Unno, which is cited only for disclosing a dc-dc converter.

Independent claims 12 and 22 and their respective dependent claims are also submitted to be allowable as reciting elements similar to that of independent claim 1.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

The Examiner argues in the Advisory Action mailed June 11, 2008, that

Reipur discloses in column 14 lines 6-33 and column 14 lines 51 to column 16 line 5 wherein charge is calculated (or otherwise determined) from the load to determine the limit of voltage charge. This limit of voltage is the target voltage discovered and the same calculations may be used to determine the DC output of the load. It is obvious that this determination of charge may be performed by feedback signals.

This argument is respectfully traversed. The phrase "**may** be performed by feedback signals" fails to show any feedback (ether internal or external) taught by the references and thus again, the rejection fails to provide any evidence of the cited references teaching or suggesting internal and external feedbacks, as recited in the pending claims.

Therefore, independent claims 1, 12 and 22 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of all pending claims is respectfully requested.

The Office Action contains characterizations of the claims and the related art to which the Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the rejections. Other reasons for the patentability of claims previously presented and not repeated here are maintained and may be revived should the filing of a full appeal brief become necessary.

Respectfully submitted,



Bart A. Fisher

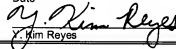
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